

Serial No.: 10/054,477
Docket No.: R0052CIP
Amendment Dated February 3, 2006
Responsive to the Office Action dated October 5, 2005

REMARKS

Prior to the present Office Action, claims 84-115 were pending. Claims 116-119 are added. Therefore, claims 84-119 are presently pending.

Please note the set of formal drawings submitted concurrently herewith.

5 A background paragraph has been added which is taken verbatim from the specification of the parent application, Serial No. 09/413,012, filed October 5, 1999, which is a continuation of Serial No. 09/133,136, filed August 12, 1998. The present application is a continuation-in-part of the parent application, whose specification was incorporated herein by reference, and therefore addition of text from the parent to the present specification is permissible. The background
10 paragraph makes it clear that the use of balloons on cannulas to enlarge surgical cavities is known in the art, and has certain disadvantages.

Discussion of Anticipation Rejections

Various claims stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent
15 No. 5,707,382 to Sierocuk, et al. Applicants respectfully disagree with the Examiner's application of Sierocuk, et al., as explained below.

Claim 84 and dependents

Claim 84 specifies an elongated tubular body and a dissecting, viewing and dilating unit
20 removably mounted on the tubular body. The dilating unit incorporates a transparent distal tip and a dilating element. The Examiner analogizes the "dilating element" of claim 84 to the inflatable balloon 15 in Sierocuk, et al.

Sierocuk, et al. does not anticipate claim 84 even before the present amendment. Specifically, in claim 84 the dilating unit including both transparent distal tip and the dilating
25 element are *removably mounted* on the tubular body. In the paragraph beginning at line 17 in column 5 of Sierocuk, et al., the "balloon 15 has a proximal end 29 affixed to the distal end of the tubular sleeve of the cannula." And further, the "proximal end of the balloon can be attached

using conventional methods such as heat sealing.” Moreover, the balloon apparently completely surrounds the distal tip 24. Consequently, the inflatable balloon is not removably mounted on the cannula, but instead is affixed thereto. This is a distinction that was not addressed by the Examiner, although on page 5 in the section discussing the section 103 rejection, the Examiner states that the “dilating unit” is removable. However, the fact is that Sierocuk, et al. merely discloses a conventional dilating balloon of the prior art which is sealed to the cannula. It is simply not removable.

To further distinguish the device of Sierocuk, et al., claim 84 has been amended to specify that the dilating element in that embodiment of the invention is non-inflatable. This amendment is believed wholly consistent with the disclosure of the present application, and of the parent, and does not introduce new matter. For example, the dilating element is alternatively described as being rigid, made of a compressible foam, and solid. Indeed, dependent claims 118-119 are added in this context. Furthermore, the background paragraph added from the parent application is intended to illustrate the advantage of the devices of the instant application over inflatable balloon dissectors of the prior art. It should be noted at the same time, however, that an inflatable dilating element may be utilized in a device with other features disclosed in the invention, and such a combination is not excluded from the scope of the application. Applicants reserve the right to claim such other features with a dilator, per se, without it being interpreted as being only non-inflatable. In other words, the amendment at issue only affects claim 84 (and 99 as discussed below).

Consequently, Applicants assert that claim 84 is allowable over Sierocuk, et al.

Claims dependent from 84 are therefore also believed to be allowable as depending from an allowable base claim. In addition, the dependent claims include a number of features that are clearly not disclosed in Sierocuk, et al., and were not adequately addressed by the Examiner’s rejection. In just one example, claim 90 provides a dilating element that has an exterior contour with peripheral faceted surfaces located distally with respect to the point of maximum cross-sectional dimension. Applicants fail to see how an inflatable balloon can form faceted surfaces,

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and to point to a general statement in Sierocuk, et al. that the balloon can be "other desired shapes" is insufficient to disclose or suggest some sort of specialized balloon with faceted surfaces.

5 New claims 118 and 119 further provide distinctions by specifying that the dilating element is either rigid or solid, neither of which is disclosed by the inflatable balloon 15 of Sierocuk, et al.

Claim 99 and dependents

10 Claim 99 specifies a non-inflatable dilating element of fixed outer dimension removably mounted on the tubular body proximal to a transparent distal tip. Again, this dilating element is removable which is entirely different from the inflation balloon 15 disclosed in Sierocuk, et al. Moreover, the dilating element is now specified as being non-inflatable. Applicants assert, therefore, that claim 99 is allowable over Sierocuk, et al.

15 The claims dependent on claim 99 are allowable on the basis of the perceived allowability of claim 99, but also because they include features that are not disclosed in Sierocuk, et al., including, e.g., the faceted surfaces of claim 107.

Discussion of Obviousness Rejections

20 Claims 85 and 100 stand rejected under 35 USC §103(a) as being unpatentable over Sierocuk, et al. in view of U.S. Patent No. 5,725,382 to Knight, et al. Applicants respectfully assert that the above remarks and amendments sufficiently distinguish the claims from Sierocuk, et al. such that any further combination with secondary references is irrelevant. However, Applicants wish to point out that because the inflatable balloon 15 of Sierocuk, et al. is affixed to the cannula, without any further alternatives described, there is no suggestion to incorporate a threaded attachment such as that shown in Knight, et al., and therefore no *prima facie* case to
25 combine the two references.

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Withdrawn claims

Applicants respectfully request reinstatement of previously withdrawn claims 86-87 and 101-102 drawn to non-elected Species C and D based on the allowance of their respective generic base claims.

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Respectfully submitted,



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